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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,222	04/01/2002	Norbert Kohler	612.41024X00	9212

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EXAMINER

RHEE, JANE J

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 05/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/030,222	Applicant(s) KOHLE ET AL.	
	Examiner Jane J Rhee	Art Unit 1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 21-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 21-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's request for reconsideration filed on 4/23/04 of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn. Prosecution is reopened and a complete Office Action on the merits follows:

Withdrawn Rejections

2. The 35 U.S.C. 103(a) rejection of claims 1-2,5-8,10-11,21-23 over Heckel et al. in view of Biby et al. has been withdrawn due to applicant's argument in 4/23/2004.
3. The 35 U.S.C. 103(a) rejection of claims 1,3-4,9 over Heckel et al. in view of Boehmer et al. has been withdrawn due to applicant's arguments in 4/23/2004.
4. The 35 U.S.C. 103(a) rejection of claims 7,8 over Heckel et al. in view of Boehmer et al. and in further view of applicant's admitted prior art has been withdrawn due to applicant's arguments in 4/23/2004.

New Rejections

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 1-2,5-8,10-11,21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maxson in view of Biby et al. (61842661).

Maxson discloses a pipe jacket comprising a volume defined by the space contained between a first enclosure interior to a second enclosure is filled with foam particles (figure 2 number 18). Maxson discloses that the volume is an annular spaced defined by the outside of a pipe placed in another pipe (figure 2 number 4 and 2). Maxson fail to disclose that between a first enclosure and a second enclosure the space is filled with vegetable foam particles. Maxson fail to disclose that the average particle size is below 5mm. Maxson fail to disclose that the vegetable foam comprises at least flour, plasticizer, another additive, a water content below 10% and preferable below 5%. Maxson fail to disclose that the space further comprises at least one of the following insulants, silicate foam particles, aerogel foam particles, or dry powders.

Biby et al. teaches that the vegetable foam comprises at least flour (col. 4 line 47), plasticizer (col. 4 line 48), another additive (col. 4 line 49), a water content below 10% preferably below 5% (col. 4 line 50), and silicate particles (col. 6 line 53) for the purpose of being able to be disposed in a wastewater treatment system having facilities for biological or other types of degradative treatment (col. 2 lines 50-55). Biby et al. teaches that the average particle size is below 5mm (col. 5 lines 8-9) for the purpose of giving the foam structure and for being inexpensive and readily available (col. 5 lines 12-14).

Therefore, it would have been obvious to one having ordinary skill in the art at the time applicant's invention was made to provide Maxson with that the

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vegetable foam comprises at least flour, plasticizer, another additive, a water content below 10% and preferable below 5%, and silicate particles in order to be disposed in a wastewater treatment system having facilities for biological or other types of degradative treatment (col. 2 lines 50-55) as taught by Biby et al.

Also, it would have been obvious to one having ordinary skill in the art at the time applicant's invention was made to provide Maxson with the average particle size that is below 5mm in order to giving the foam structure and for being inexpensive and readily available (col. 5 lines 12-14) as taught by Biby et al.

6. Claims 1,3-4,9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maxson in view of Boehmer et al. (5272181).

Maxson discloses the thermal insulation described above. Maxson et al. fail to disclose that the vegetable foam is solubilized by an aqueous fluid. Maxson et al. fail to disclose that the vegetable foam have the following properties, thermal conductivity ranging between 0.03 and 0.06W/mK and at least partial solubility in an aqueous fluid. Maxson fail to disclose that the fluid is about 1N soda.

Boehmer et al. teaches expanded vegetable foam material is solublized by an aqueous fluid (col. 1 lines 49) for the purpose of being able to be placed on the subsurface layer of a landfill or to be disposed in a wastewater treatment system having facilities for biological or other types of degradative treatment (col. 2 lines 50-55).

Therefore, it would have been obvious to one having ordinary skill in the art at the time applicant's invention was made to provide Maxson with expanded

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vegetable foam material that is solublized by an aqueous fluid in order to be able to be placed on the subsurface layer of a landfill or to be disposed in a wastewater treatment system having facilities for biological or other types of degradative treatment (col. 2 lines 50-55) as taught by Boehmer et al.

Boehmer et al. discloses that vegetable foam comprises at least flour (col. 3 lines 50-52), plasticizer (col. 4 line 14), another additive (col. 3 lines 13-15), a water content below 10% (col. 8 line 15) as desired by the applicant, therefore, it would have been obvious to one having ordinary skill in the art at the time applicant's invention was made to provide that the aqueous fluid that the vegetable foam is solubized by is about 1N soda and that the vegetable foam have a thermal conductivity ranging between 0.03 and 0.06W/mK, since it has been held that discovering optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F.2d.

7. Claims 7, 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maxson in view of Boehmer et al. (5272181) and in further view of applicant's admitted prior art (specification page 2).

Maxson discloses a pipe jacket comprising a volume defined by the space contained between a first enclosure interior to a second enclosure is filled with foam particles (figure 2 number 18). Boehmer et al. teaches vegetable foam material (col. 3 –col. 4) for the purpose of being able to be disposed in a wastewater treatment system having facilities for biological or other types of degradative treatment (col. 2 lines 50-55).

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Therefore, it would have been obvious to one having ordinary skill in the art at the time applicant's invention was made to provide Maxson with vegetable foam material in order to be disposed in a wastewater treatment system having facilities for biological or other types of degradative treatment (col. 2 lines 50-55) as taught by Boehmer et al.

Maxson fail to disclose that the enclosure consist of a string of tubings. Applicant's admitted prior art teaches that it is common to have a whole string of production tubing during production of a well for servicing operations on downhole equipments or installations (page 2 of specification line 9-12).

Therefore, it would have been obvious to one having ordinary skill in the art at the time applicant's invention was made to provide Maxson with string of production tubing during production of a well for servicing operations on downhole equipments or installations (page 2 of specification line 9-12) as taught by applicant's admitted prior art.

Response to Arguments

8. Applicant's arguments with respect to claims 1-11, 21-23 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jane J Rhee whose telephone number is 571-272-1499. The examiner can normally be reached on M-F.

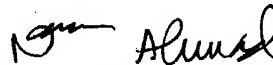
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nasser Ahmad can be reached on 571-272-1487. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jane Rhee
May 5, 2004



NASSER AHMAD
PRIMARY EXAMINER